

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENJI OSE

Appeal 2007-3541
Application 09/992,597
Technology Center 3600

Decided: October 29, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and
THOMAS A. WALTZ, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

REMAND UNDER 37 C.F.R. § 41.50(a)(1)
AND ORDER UNDER 37 C.F.R. § 41.50(d)

In a Remand and Order dated February 28, 2007, we ordered Appellant to provide a full explanation of the meaning of the claim 34 recitation "wherein the finger contact projection protrudes radially inwardly from a radially innermost outer peripheral surface of the dial so that ...". We also remanded the application to the Examiner to obtain the Examiner's interpretation of the claim language on record. Unfortunately, Appellant's

response has not clarified the issue but only raises additional questions pertaining to the scope of the claimed invention.

We understand Appellant's explanation that the radius in the claimed device radiates from the rotational axis (A) depicted in Figure 13. However, Appellant goes on to state that "[t]he outer peripheral surface of Appellant's rotatable dial (570) is marked in bold outline in the attached Exhibit A" (Appellant's initial response 2, second para.). While Appellant does not take issue with the Examiner's interpretation that the recitation "radially innermost outer peripheral surface of the dial" refers to surface (512) of Figure 13, Appellant's Exhibit A presents Figures 14 and 15 which do not show surface (512) of Figure 13. The bold outlines provided by Appellant in Figures 14 and 15 cover a portion of surface (570) that is orthogonal to surface (512). Accordingly, Appellant is ordered to provide a copy of Figure 13 which labels the "radially innermost outer peripheral surface of the dial."

Also, as noted by Appellant, claim 34 also requires that the finger contact projection (584) of the device "protrudes radially inwardly from a radially innermost outer peripheral surface of the dial." We understand Appellant's statement in the response that this feature requires that the finger contact projection "extends from the rotatable dial in a direction of the rotational axis" (Response 2, third para.). Clearly, element (584) extends from surface (570) in the direction of axis A. But Appellant also states that the finger contact projection (584) "extends radially away from the outer

peripheral surface" (*id.*). If the outer peripheral surface is surface (512), as understood by the Examiner, element (584) extends radially inwardly from surface (512) not away from surface (512). Clarification is required.

Appellant should also clarify what is meant by at least a portion of the finger contact projection (584) "is located a distance from the rotational axis that is less than the length of the radius (R) (labeled in the exhibits) that extends from the rotational axis to the radially innermost outer peripheral surface(s)" (*id.*). Is this simply to state that element (584), in extending across the entirety of surface (570), comprises a multitude of portions, some of which are located at a distance less than the radius, and some of which are located at the radial distance. Again, clarification is required.

Also, in the reply to Appellant's initial response, the Examiner states that "the language 'radially innermost'" fails to be described in the specification as originally filed (page 2, second para.). Accordingly, once Appellant has responded to this Order, the Examiner should consider whether a rejection under 35 U.S.C. § 112, first paragraph, description requirement, is appropriate in light of this remark. In addition, the Examiner should provide a reply to Appellant's response.

In conclusion, Appellant is ordered under the provisions of 37 C.F.R. § 41.50(d) to provide the clarification noted above, and the application is remanded to the Examiner for submission of an Answer to Appellant's response and to consider a rejection of the claim language at issue under 35

U.S.C. § 112, first paragraph, for failure to comply with the description requirement.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R.

§ 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board. Any Supplemental Answer by the Examiner should only be issued after Appellant complies with our Order.

REMAND TO THE EXAMINER/ORDER

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